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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Beyer Law Group LLP P.O. BOX 1687 Cupertino, CA 95015-1687			EXAMINER KANE, CORDELLA P	
			ART UNIT 2432	PAPER NUMBER
			MAIL DATE 02/11/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/749,911

**Applicant(s)**

AVRITCH ET AL.

**Examiner**

CORDELIA KANE

**Art Unit**

2432

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7,9,10,12-17,19-36,38-40 and 42-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9,10,12-17,19-36,38-40 and 42-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on January 20, 2009 was filed after the mailing date of the non-final action on August 22, 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 2, 4, 9, 10, 12 - 17, 19, 21 - 24, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montville (6,356,937), and further in view of Caldwell et al's US Publication 2002/0046286 A1.
5. Referring to claim 1, Montville teaches:
  - a. Providing a service request comprising information about the email message (column 23, lines 53-58).
  - b. Processing a portion of the request to determine a result, providing the result to the senders side, incorporating the result in the email message and

transmitting the email message (column 16, lines 14-27). The processing the portion of the request is evidence by encryption and digital signing of the message which is then sent.

c. Receiving an email message that is a result incorporated email message, and processing the email to assess the integrity of it (column 16, lines 43-54).

The processing the email message is evidence by the decrypting and digital signature verification.

6. Montville does not explicitly disclose the keys being a service private key and the request being sent over a network. However, Caldwell discloses that the client is connected to the service over the network (Figure 1, 13/23) and encrypting messages using the public and private key data that is pre-stored (page 2, end of paragraph 14).

7. Montville and Caldwell are analogous art because they are from the same field of endeavor, communication over the internet. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Caldwell before him or her, to modify the system of Montville to include the service keys of Caldwell. The suggestion/motivation for doing so would have been to permit data to reside at the servers where it is generated and used and yet to provide second access to the data to a privileged degree (page 1, paragraph 8).

8. Referring to claim 2, Montville teaches:

d. The step of processing the request includes generating a digital signature, and the result includes a digital signature (column 16, line 21). Processing the digital signature includes using a private key(column 8, lines 23-24).

- e. The step of processing the received email message includes processing the digital signature (column 16, line 54).
9. Montville does not explicitly disclose a private key associated with the service, and a public key associated with the service. However, Caldwell discloses a service private and public key (page 2, end of paragraph 14). The examiner takes official notice that it is well known to one skilled in the art that when using a digital signature that the corresponding public key is used for decryption.
10. Montville and Caldwell are analogous art because they are from the same field of endeavor, communication over the internet. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Caldwell before him or her, to modify the system of Montville to include the service keys of Caldwell. The suggestion/motivation for doing so would have been to permit data to reside at the servers where it is generated and used and yet to provide second access to the data to a privileged degree (page 1, paragraph 8).
11. Referring to claim 4, Montville teaches:
- f. Determining whether it is a result incorporated email message (column 16, lines 53-55).
  - g. If it is not a result-incorporated email message, performing a first particular action (column 24, lines 48-50). The particular action being downloading and viewing the message.
12. Referring to claim 9, Montville teaches:

- h. The result includes an indication of a level of certification (column 16, line 21, and column 7, lines 32-33).
  - i. The integrity is assessed in view of the indication of the level of certification (column 16, line 54).
- 13. Referring to claim 10, Montville teaches filtering the email message based on the determined level of certification (column 21, lines 15-19).
- 14. Referring to claim 12, Montville teaches:
  - j. The request includes sender verification information (column 16, lines 6-9).
  - k. The processing of the verification information is inherent from the log-in and password steps. It would be inherent that the password would be verified before any further steps were taken.
- 15. Referring to claim 13, Montville teaches that the request includes a digest of the message body (column 8, lines 17-18).
- 16. Referring to claim 14, Montville teaches that the request does not include the message body or information from which the message body can be derived (column 8, lines 17-21).
- 17. Referring to claim 15, Montville teaches the digest is generated using a SHA algorithm (column 8, lines 29-31).
- 18. Referring to claim 16, Montville teaches deriving the portion of the request from which the result was determined, and then processing the portion of the request and the

email message (column 16, lines 53-54). This deriving and processing is the decryption process that is performed.

19. Referring to claim 17, Montville teaches:

l. Deriving the portion of the request includes using a decryption algorithm (column 16, lines 53-54). That the email message is digitally signed (column 16, line 21). The examiner takes official notice that it is well known to one skilled in the art that when using a digital signature that the corresponding public key is used for decryption.

m. Generating a digest of the message body and processing that digest (column 7, lines 17-18).

20. Montville does not explicitly disclose public service key. However, Caldwell discloses a service private and public key (page 2, end of paragraph 14). Montville and Caldwell are analogous art because they are from the same field of endeavor, communication over the internet. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Caldwell before him or her, to modify the system of Montville to include the service keys of Caldwell. The suggestion/motivation for doing so would have been to permit data to reside at the servers where it is generated and used and yet to provide second access to the data to a privileged degree (page 1, paragraph 8).

21. Referring to claim 19, Montville teaches that the result is incorporated into the message by including it in the header (column 16, lines 43-47). The content of the message is included in the header which would inherently include the result.

22. Referring to claim 21, Montville teaches that the sender is nominally associated with the senders side and that a physical location is associated with the sender (column 11, lines 6-10). The use of a driver's license or passport to prove the senders credentials means that the physically location of the sender would be inherent.

23. Referring to claim 22, Montville teaches that the sender is nominally associated with the senders side and how to locate the sender at a later date (column 11, lines 6-10). The use of a driver's license or passport to prove the senders credentials means that the address of the sender would be included and therefor finding them at a later date would be inherent.

24. Referring to claim 23, Montville teaches associating a degree of certainty with the determination (column 11, lines 1-6).

25. Referring to claim 24, Montville teaches that the result includes an indication of the degree of certainty (column 7, lines 32-33). Since the certificate level is included in the email it is inherent.

26. Referring to claim 35, Montville teaches that the portion of the request includes indication of the email address of the sender, and receiver (column 16, lines 14-27). Montville also teaches that the request includes a digest of the message body (column 8, lines 17-18).

27. Referring to claim 36, Montville teaches that processing the received result to assess integrity is without interacting with the service (column 26, lines 56-66).

28. Claims 5 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montville in view of Caldwell and further in view of Zoken. Montville in view of Caldwell

discloses all the limitations of the parent claim. Montville in view of Caldwell does not appear to explicitly disclose performing a particular action based on the assessment of the integrity of the message. However, Zoken discloses:

- n. Organizing an email inbox based on the integrity assessment (column 3, lines 30-35). The organization of the inbox is inherent from the fact that the email is filtered and isolated from other emails. (claims 5 and 7)
- o. Displaying an indication of the outcome of assessing the integrity (column 3, lines 36-39). The outcome is displayed by listing the results generated from the databases accessed.

29. Montville in view of Caldwell and Zoken are analogous art because they are from the same field of endeavor, email verification. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Caldwell and Zoken before him or her, to modify Montville in view of Caldwell to include performing an action based on the integrity assessment of Zoken. The motivation for doing so would have been to treat similarly certified documents the same.

30. Claim 20 is rejected under 35 USC 103 (a) as being obvious over Montville in view of Caldwell in view of Wayne Baldwin et al's US Patent 5,877,757. Montville in view of Caldwell discloses all the limitations of the parent claim. Montville in view of Caldwell does not appear to explicitly disclose that the message is formatted according to SMTP. However, Baldwin discloses SMTP is a well known in the art of networking (column 6, lines 42-45). Montville in view of Caldwell and Baldwin are analogous art

because they are from the same field of endeavor, networks. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Caldwell and Baldwin before him or her, to modify the email and header of Montville in view of Caldwell to include SMTP of Baldwin. The motivation for doing so would have been that SMTP is well known in the art (column 6, lines 42-45) and therefor the email can be processed by the majority of email clients.

31. Claims 25, 26 and 31 – 34 are rejected under 35 USC 103 (a) as being obvious over Montville in view of Caldwell in view of McKeon. Montville in view of Caldwell discloses all the limitations of the parent claim, as well as that the user is a subscriber (Montville, column 3, line 10). Montville in view of Caldwell does not appear to explicitly disclose how the subscriber joins the service. However, McKeon discloses:

- p. The subscriber agreeing to terms of service (column 6, line 15). (claim 25)
- q. Signing and agreeing to terms of service inherently creates the initial subscription to the service. (claim 26)
- r. The sender requesting to subscribe to the service then sending an inquiry message to the send via mail, then observing how the sender handles the inquiry message (column 6, lines 7-16). (claim 31, 32, and 33).
- s. A signature is required (column 6, lines 23-26). The signature is inherent by the fact there is a contract.

32. Montville in view of Caldwell and McKeon are analogous art because they are from the same field of endeavor, certifying a subscriber. At the time of the invention, it

would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Caldwell and McKeon before him or her, to modify Montville in view of Caldwell to include the terms of service of McKeon. The motivation for doing so would have been it makes the certification process more secure (McKeon, column 1, lines 62-64).

33. Claims 27 – 30 and 44 – 46 are rejected under 35 USC 103 (a) as being obvious over Montville in view of Caldwell in view of Heiner. Montville in view of Caldwell discloses all the limitations of the parent claim as well as the user having a plurality of email addresses (Montville, column 14, line 16) . Montville in view of Caldwell does not appear to explicitly disclose using an inquiry message with the sender, and filtering emails based on a collective characteristic. However, Heiner discloses:

- t. Sending an inquiry message to the email address and observing the behavior of the sender (column 3, lines 46-48). (claim 27)
- u. Sending a reply message back to the service (column 3, lines 47-48). (claim 28)
- v. Including in the inquiry message a set of instructions (column 3, lines 59-60). (claim 29)
- w. The instructions include a link to a particular URL or web page (column 4, lines 4-5). (claim 30)
- x. Determining a collective characteristic, not registering, of the plurality of emails (column 4, lines 26-31). (claim 44)

- y. Performing a particular action in not providing the result, otherwise known as not delivering the email (column 4, lines 34-35). (claims 45 and 46)
34. Montville in view of Caldwell and Heiner are analogous art because they are from same field of endeavor, email certification. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Caldwell and Heiner before him or her, to modify Montville in view of Caldwell to include the inquiry messages and filtering of Heiner. The motivation for doing so would have been that junk mail is a known problem for users (column 1, lines 11-12) and this is an effective way to prevent unwanted emails(column 1, lines 57-60).
35. Claims 38 - 40, 42, and 43 are rejected under 35 USC 103 (a) as being obvious over Montville in view of Caldwell in view of Castell. Montville in view of Caldwell discloses all the limitations of the parent claim. Montville in view of Caldwell does not appear to explicitly disclose generating a second result determining if it was generated as a result of a virus, and then performing a particular action. However, Castell discloses:
- z. Generating a secondary result (page 3, paragraph 35). (claim 38)
    - aa. Providing an indication of the secondary result (pages 3-4, paragraph 39).  
The indication of the secondary result includes determining to not forward the email on. (claim 38)
    - bb. Performing a particular action based on the secondary result (pages 3-4, paragraph 39). (claim 39).

- cc. The email message was generated as the result of a virus (page 3, paragraph 33). The problem is viruses, so it is inherent that viruses are what the filter is looking for. (claim 40)
- dd. Not sending the message (page 3-4, paragraph 39). While it does not specifically say how it is not sent, when combined with the method of Montville in view of Caldwell not sending it would mean that no other certification of any kind occurred including not determining the result and not providing the result to the sender. (claim 42, 43)
36. Montville in view of Caldwell and Castell are analogous art because they are from the same field of endeavor, protecting emails. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Caldwell and Castell before him or her, to modify the sending methods of Montville in view of Caldwell to include the virus screening of Castell. The motivation for doing so would have been that it prevents flooding the network (Castell, page 3, paragraph 33).
37. Claims 47 – 49 are rejected under 35 USC 103 (a) as being obvious over Montville in view of Caldwell in view of Morkel. Montville in view of Caldwell discloses all the limitations of the parent claim. Montville in view of Caldwell does not appear to explicitly disclose providing contact information of the sender to the receiver. However, Morkel discloses:

- ee. Processing a request from the receiver to obtain contact information and then providing that contact information (page 1, paragraph 8). (claim 47)
  - ff. It would be inherent that the email would be in a format appropriate for the client so that the requestor would be able to read the contact information. (claim 48)
  - gg. A link to advertising information relative to the client (pages 3-4, paragraph 39). (claim 49)
38. Montville in view of Caldwell and Morkel are analogous art because they are from the same field of endeavor, processing emails. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville in view of Caldwell and Morkel before him or her, to modify Montville in view of Caldwell to include the providing contact information of Morkel. The motivation for doing so would have been that peoples contact information changes frequently (Morkel, page 1, paragraph 3) and that contact information methods often lack security features to prevent unwanted access (Morkel, page 1, paragraph 5).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CORDELIA KANE whose telephone number is (571)272-7771. The examiner can normally be reached on Monday - Thursday 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. K./  
Examiner, Art Unit 2432

/Gilberto Barron Jr./  
Supervisory Patent Examiner, Art Unit 2432